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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,114	07/07/2003	Richard Levy	01064.0011-08-000	7674

7590 07/19/2005

THE LAW OFFICES OF ROBERT J. EICHELBURG  
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EXAMINER
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GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/614,114	Applicant(s) LEVY, RICHARD	
	Examiner Jill M. Gray	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 57-63,65-71,73-76 and 87-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-63,65-71,73-76 and 87-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

The provisional rejection of claims 57-63, 65-71, 73, 76, and 87-90 under the judicially created doctrine of obviousness-type double patenting is moot in view of the abandonment of the copending application.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 62-63 and 70-71 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a "KITCHENAID KSM 90 mixer with wire whip attachment, Examples and polyisobutylene lubricant for cable applications, does not reasonably provide enablement for the broad language of "wire" or any lubricant applied to a cable substrate, page 12. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. More specifically, the term "wire" embraces a host of wires not supported by the specification, such as electric wire, twist tie wires, or circuits. The reliance upon the disclosure of the "KITCHENAID KSM 90" mixer with a wire whip attachment is limited to mixing apparatus used in blending the superabsorbent and lubricant. Also, the wire whip attachment, while being a "wire substrate" coated with the composition during mixing is insufficient support for the breadth of claims 63 and 71. And, it is not clear on this

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record how "a method of protecting a substrate..." (claim 65) wherein the substrate is a "KITCHENAID KSM 90" mixer with "wire" (claim 71) whip attachment, used in blending the components, as argued by applicants applies. There is no reference or data with respect to protection of the mixer. As to claims 62 and 70, the specification as originally filed, only describes (in the background of the invention) polyisobutylene as a lubricant for cables. There is no disclosure in that portion of the specification construed to be the subject matter defined by the invention of cables as a substrate. Accordingly, applicants' claims are not commensurate in scope with the teachings in the specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57, 63, 65-71, 73, 76 and 87-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman 5,218,011 in view of Marciano-Agostinelli et al, 5,049,593 (Marciano-Agostinelli) for reasons of record.

### ***Response to Arguments***

Applicant's arguments filed April 22, 2005 have been fully considered but they are not persuasive. Applicants argue that both Freeman and Marciano-Agostinelli either taken alone or in combination with one another neither teach nor suggest applicant's

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essentially water free composition, wherein the composition comprises a superabsorbent polymer and material for lubricating a surface as essentially as claimed in present claim 57.

In this concern, Freeman teaches a water free composition that comprises a gel matrix, thickener and water absorbent polymer disposed therein, wherein the gel matrix can be an ester, as required by the present claims. Thus, the teachings of Freeman and Marciano-Agostinelli would have provided a suggestion for the composition as claimed by applicant.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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J.M. Gray/dh  
June 28, 2005

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